## Remarks/Arguments

Claims 1-12 are pending and rejected.

Claims 1, 3, and 6-10 are amended to correct informalities. Claims 13-18 are added.

# Claim Rejections - 35 U.S.C. § 102

Responsive to the rejection of claims 1-12 under 35 U.S.C. § 102(b) as being anticipated by US 5,686,954 ("Yoshinobu"), applicants respectfully submit that Yoshinobu does not anticipate these claims for reasons discussed below. Following the sequence of discussion in the Office Action, claims 5-10 are discussed first.

Claim 5 recites a receiving device receiving and decoding compressed digital video signals, said receiver device comprising:

a receiving means for receiving and selecting between a first compressed digital video signal from a network source and a second compressed digital video signal and a display message data signal from a local source;

a decoder coupled to said receiving means for decoding said selected one of said first and second compressed digital signals to form a video signal;

control means coupled to said receiving means for controlling selection between said first and second compressed digital video signals, and responsive to selection of said second compressed digital video signal, receiving said display message data signal; and

means for combining a display message formed from said display message data signal with said video signal decoded from said second compressed digital video signal to generate a combined video signal for display.

Contrary to the statements made in the Office Action, Yoshinobu does not disclose or suggest the combining means for combining the display message data signal with a video signal decoded from the second compressed digital video signal to generate a combined video signal for display. The Office Action relies upon FIGs. 20 and 21 as disclosing the combining means. FIG. 20 is a flow chart for the processing in the system control section 100 upon program search and program reservation. See col. 28, lines 35-38. During the processing, on-screen displays

(OSDs) for program information shown in FIGs. 17-19 are displayed. See col. 29, lines 49-55, and col. 29, lines 3-8 and 21-28. However, the OSDs, even interpreted as the display message data signal, occupy the whole screen. As such, the OSDs are not combined with a decoded video signal decoded from a compressed video signal (the second compressed digital video signal in the claim) from the minidisk (possibly relied upon as the local source). As such, FIG. 20 does not disclose or suggest the combining means.

In fact, the OSDs shown in FIGs. 17-19 cannot be interpreted as the display message signal because the OSD data are extracted from the packet 24, not from the minidisk (relied upon as the local source). See col. 28, lines 49-55.

FIG. 21 is a flow chart for the processing in the system control section 100 for the rearranged reproduction mode. See col. 30, lines 36-37. The recording/reproducing device 200 records information regarding a recorded content into a recording area (UTOC) separate from the main recording data. See col. 4. lines 1-5. When the program according to the flow chart is started, the data in the UTOC is at first read from the mini-disc 201, and the system control section 100 forms display data for the information regarding the recorded contents in the minidisk 201 based on the written UTOC information and supplies the same by way of the video display processing section 74 to the CRT display 75 and display the data. See col. 30, lines 39-47. For example, in FIG. 18, when all the programs attached with marks "o" in the program table tbl for each of items in FIG. 18C are recorded in the minidisk 201, the information regarding the title for each of the programs and the broadcasting time are displayed as the list shown in FIG. 22A as the information regarding the recorded contents prepared based on the UTOC information. See col. 30, lines 48-54. However, even if the displayed UTOC information shown in FIG. 22A is interpreted as the display message data signal, Yoshinobu does not disclose or suggest the combining means because the UTOC information occupies the whole display area and is not combined with a video signal decoded from a compressed digital video signal from the minidisk 201 (the local source), as required by claim 5.

As such, neither FIG. 20 nor FIG. 21 discloses or suggests the combining means recited in claim 5. In fact, all of the OSDs shown in the figures, including FIGs. 9, 15, 16A-16C, 17A-17C, 18A-18C, 19A-19C, and 22A-22B, occupy the whole display area. As such Yoshinobu does not disclose or suggest the combining means. This is because Yoshinobu is concerned with the display of program

information, not the combining of a decoded compressed video signal from a local source with a display message data signal from the same local source.

In light of the fact that Yoshinobu does not disclose or suggest a receiving device receiving and decoding compressed digital signals, comprising means for combining a display message formed from a display message data signal from a local source with a video signal decoded from a compressed digital video signal from the local source to generate a combined video signal for display, claim 5, and dependent claims 6-10, are not anticipated by Yoshinobu, and are patentable over Yoshinobu.

Furthermore, claim 7 recites that the display message data signal is a recorder status message. The Office Action indicates that claims 9, 10, and 13 disclose such a feature. However, claims 9, 10, and 13 are concerned with the display of program information extracted from received broadcast wave signals and program information related to recorded program signals. This information is not a recorder status message because it is the information of a broadcast program, for example the duration of a broadcast program. As such, Yoshinobu does not anticipate claim 7 for this reason alone.

Since Yoshinobu does not disclose or suggest a combining means in claim 5, it also does not disclose or suggest the display message combiner recited in claim 1 for combining a status message signal indicative of an operation mode of the digital reproducing apparatus with a decoded video signal decoded from a compressed digital video signal bit stream from a recorded medium.

Furthermore, as discussed above with respect to claim 7, Yoshinobu discloses the display of the program information, not status of a recorder/player. As such, Yoshinobu also does not disclose or suggest the generator recited in claim 1 for generating a status message signal indicative of an operating mode of the apparatus.

In light of the fact that Yoshinobu does not disclose or suggest a digital apparatus for reproducing a digital video representative signal stored on a recorded medium connected to a receiving device including a decoder, the apparatus comprising a generator generating a status message signal indicative of an operating mode of the apparatus, and a display message combiner for combining the status message signal with a decoded video signal decoded from a compressed digital video signal bit stream from a recorded medium, applicants submit that claim 1, and dependent claims 2-4 and 11-12 are not anticipated by Yoshinobu and are patentable over Yoshinobu.

## **New Claims**

Claims 13-18 are added, and directly and indirectly depend from claim 1. Support for the features in the added claims can be found, for example, at page 8, lines 3-27 and FIG. 2. These claims are patentable at least from their dependence from claim 1.

## Conclusion

Having fully addressed the Examiner's objections and rejections it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the applicant's attorney at (609) 734-6813, so that a mutually convenient date and time for a telephonic interview may be scheduled.

#### <u>Fee</u>

No fee is believed due. However, if a fee is due, please charge the fee to Deposit Account 07-0832.

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#### **CERTIFICATE OF MAILING**

I hereby certify that this amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to [Mail Stop Amendment], Commissioner for Patents, Alexandria, Virginia 22313-1450 on:

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Karen Schlauch

Date